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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Berthold Types Limited

Serial No.: 75/866,912

Mark: **WHITTINGHAM**

Filed: December 9, 1999

Examining Attorney: Amos T. Matthews

Law Office 108

Attorney's Reference: 31349-152729

Honorable Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513



08-28-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #39

APPLICANT'S APPEAL BRIEF

Introduction

This matter is before the Board on Appeal by the Applicant from a final refusal of registration based upon the section 2(e)(4) of the Trademark Act.

The Record

The record for this appeal consists of the application, and a number of Office Actions and responses.

The Examiner's Position

It is the Examiner's position that the mark WHITTINGHAM is primarily merely a surname.

The Applicant's Position

It is the Applicant's position that the primary significance of the mark is not that of a surname.

Argument

The Examining Attorney has maintained the refusal of registration under Section 2(e)(4) of the Trademark Act. Applicant respectfully requests that such refusal be withdrawn for the following reasons.

First, it is well settled that the test to be applied in determining whether or not a mark is primarily merely a surname is its primary significance to the purchasing public. See In re Harris-Intertype Corp., 186 USPQ 238, (CCPA 1975); In re Kahan and Weisz Jewelry Manufacturing Corp., 184 USPQ 421, (CCPA 1975); and Ex parte Rivera Watch Corp., 106 USPQ 145 (Com'r. 1955). Moreover, it is clear that the burden is on the Patent and Trademark Office to prove that the subject matter for registration is primarily merely a surname. In re Kahan and Weisz Jewelry Manufacturing Corp., supra. Thus, it is incumbent upon the Examining Attorney in the first instance to present evidence which is sufficient to make out a prima facie showing in support of the contention that a particular mark is primarily merely a surname, thereby shifting to applicant the burden of rebutting such evidence. See In re Ciclo Tecnica Industrial, S.A., 194 USPQ 547 (TTAB 1977) and cases cited therein.

As evidence of his contention that the term WHITTINGHAM is primarily merely a surname, the Examining Attorney has made of record excerpts from the PHONEDISC USA database. The relevant telephone directory listings, which were gathered from telephone directories including a total of over 115,000,000 listings refer to only 300 or so different people (after eliminating duplicate entries) bearing the surname WHITTINGHAM. In effect, only 0.0000026 of the people covered in the database have the surname WHITTINGHAM. This translates to an average six people in each of the fifty States who are named WHITTINGHAM.

The Examining Attorney argues that, under Applicant's analysis, a surname such as "Lopez" would never be affirmed. The Examining Attorney states that the surname "Lopez" constitutes 000055 of the database which translates to approximately 63,250 listings. 63,250 listings is not comparable to 300 total listings for "Whittingham." Applicant does not dispute that the surname "Lopez" is primarily merely a surname, but the term "Whittingham" does not rise to the same level of "Lopez" as primarily merely a surname.

In In re Kahan & Weisz Jewelry Mfg. Corp., supra, where the very same issue was involved, the Court of Customs and Patent Appeals stated:

Although the use of a telephone directory may be considered a factor in determining whether a mark is primarily merely a surname, we do not find this, standing alone, to be determinative of the issue. This is particularly true here where the Patent Office only relied upon six listings in the Manhattan telephone directory supplied by appellant. Such a showing does not establish that the primary significance of DUCHARME to the purchasing public is that of a surname." (citations omitted)

Clearly, the total of only about 300 different people having WHITTINGHAM as a surname can have only limited persuasive impact in view of the fact that these were the only references found out of 115,000,000 listings. See In re Garan Inc., 3 USPQ 2d 1537 (TTAB 1987).

In In re Garan, the Examining Attorney relied upon six directory and NEXIS listings of GARAN as a surname in the NEXIS OMNI library which consists of more than 145 files of information from U.S. and overseas newspapers, magazines, journals, newsletters, wire services and broadcast transcripts; more than 21 billion characters of information and over nine million stories all in full text, In re Garan, supra, p. 1540 f.n. 10. In the present case, the Examining Attorney has relied upon a larger "surname" database and has located an average of a mere 6 surname listings of WHITTINGHAM per state.

While rare surnames may nevertheless be considered to be "primarily merely" surnames, e.g., In re Possis Medical, Inc., 230 USPQ 72,74 (TTAB 1986), it has been held that the degree of a surname's rareness has a material impact on the weight given the evidence of surname use. In re Garan Inc., supra, p. 1540. As in the Garan case, it is submitted that the evidence made of record by the Examining Attorney only slightly supports the position that WHITTINGHAM is "primarily merely a surname."

In a case such as this, where there are only an average of 6 persons per state with the name WHITTINGHAM, "it is incumbent upon the Examining Attorney in the first instance to present evidence which is at least sufficient to make out a prima facie showing in support of the contention that a particular mark is primarily merely a surname..." In re Wickuler-Kupper-Brauerei KGaA, 221 USPQ 469,470 (TTAB 1983).

The Examining Attorney also provides pages from MERRIAM WEBSTER'S COLLEGIATE DICTIONARY and WEBSTER'S NEW GEOGRAPHIC DICTIONARY to show that the term "Whittingham" does not have a well known meaning. However, the pages from WEBSTER'S NEW GEOGRAPHIC DICTIONARY attached to the office action show a reference for Lake Whittingham in Vermont. The Examining Attorney's own evidence shows that the term "Whittingham" has a "readily recognized meaning apart from its surname significance". This readily recognized meaning in addition to the other meanings Applicant referred to in its response of May 24, 2001, that of a town in Vermont, a parish in the U.K., and a fish and wildlife management area in New Jersey, is evidence that the term Whittingham would be more likely recognized as a geographic designation than a surname.

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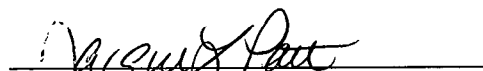
Moreover, the fact that the suffix "-ham" is a common designation for geographic locations, such as, Birmingham, Alabama; Cheltenham, Maryland; Chatham, New Jersey; Chatham, Ohio; Birmingham, Michigan; Birmingham, Missouri; Bingham, Maine; Bellingham, Washington; Bellingham, Maine; Aldenham, United Kingdom; Tottenham, United Kingdom; Stoneham, Massachusetts; Shoreham, United Kingdom; Rockingham, North Carolina; Effingham, Illinois; Durham, North Carolina; Framingham, Massachusetts; Nottingham, Pennsylvania; would leave consumers with the first impression that "Whittingham" may be a geographic location rather than a surname.

Therefore, it is respectfully submitted that the initial impression of the term WHITTINGHAM would be that of a geographic designation and not that of a surname. In fact, the term WHITTINGHAM did not initially strike the Examining Attorney as being a surname, as that issue was not raised in the first Office Action.

In view of the foregoing, it is requested that the refusal of registration be withdrawn, and that this mark be forwarded for publication in the Official Gazette.

Respectfully submitted,

By:



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